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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MADSON & METCALF 15 WEST SOUTH TEMPLE SUITE 900 SALT LAKE CITY, UT 84101			HAILU, TADESSE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/928,856	<b>Applicant(s)</b> VIGIL ET AL	
	<b>Examiner</b> Tadesse Hailu	<b>Art Unit</b> 2173	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This Office Action is in response to the Amendment submitted/entered with filing of RCE on March 14, 2005. 9/20/2004.

#### *Status of the claims*

2. The pending claims 1 through 40 are examined herein as follows.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 7, 8, 13-20, 23, 24, 29-35, and 37 are rejected under 35

U.S.C. 102(e) as being anticipated by Puskala (WO 02/070088 A1).

With regard to claim 1:

Puskala discloses a hand-held wireless telecommunications device (Fig. 2, #10) configured to send a text message to a recipient (20) through use of a global computer network (30, 47), the wireless device (10) comprising:

a processor (50);

an input component (60) in electronic communication with the processor for a user to enter user input,

a display (52) in electronic communication with the processor that displays information to the User;

a communications module (54) in electronic communication with the processor for communicating with the global computer network;

memory (56) in electronic communication with the processor for storing data;

a messaging module (62) comprising instructions that are executable by the processor for implementing a method comprising:

connecting (15) the wireless device to the global computer network (Fig. 1);

displaying (52) network data received from the global computer network on the display (e.g., Fig. 5);

enabling the user to establish communications with a message web site (page 4, lines 12-20);

providing to the user a message user interface to select a message from a plurality of predefined ("preconfigured") messages (see Table 1, page 22, lines 5-19, Fig. 5, page 19, lines 13-page 20, lines 7), each of the plurality of messages being predefined to be sent to a recipient (e.g., page 4, lines 12-20), wherein the messaging module receives the plurality of predefined messages from the message web site based on a user identification and displays the message user interface on the display thereby enabling the user to select the message from the plurality of predefined messages (page 5, lines ; and (page 4, lines 21-page 5, lines 8);

providing to the user (e.g., wireless device **10**) a recipient user interface (Fig. 9, **90** or Fig. 10, **100**) to select the recipient (page 23, lines 1-10, also see Figs. 9 and 10); and

sending (e.g., via communication link **15**) the message to the recipient (e.g., wireless device **20**) through the global computer network (page 29, lines 20-23)

With regard to claim 2:

Puskala further discloses that said hand-held wireless telecommunications device is a mobile telephone (Fig. 2, page 9, lines 8-13).

With regard to claim 3:

Puskala further discloses that said hand-held wireless telecommunications device is a personal digital assistant (page 9, lines 8-13).

With regard to claims 4, 20 and 35:

Puskala further discloses that said message is a text message (Fig. 5, page 1, lines 24-25, page 16, lines 7-11).

With regard to claim 7:

Puskala further discloses that said message is an electronic mail messages (or e-mail) (page 1, lines 10-13).

With regard to claim 8:

Puskala further discloses that said network data comprises Wireless Markup Language (WML) (page 13, lines 15-17).

With regard to claim 13:

Puskala discloses a web site (Fig. 1) for editing and storing preconfigured messages to be used with hand-held wireless telecommunications devices (e.g., devices 10 and 20), the web site comprising:

- a web server (Fig. 1, or 11) for serving web data to a plurality of wireless devices;
- a computer (Fig. 1, or 11) enabling operation of the web server, the computer being in electronic communication with a storage device (Fig. 1, or 11) storing instructions executable by the computer for implementing a method comprising:

- allowing a wireless device to contact the web site via a global computer network (column 4, lines 12-20);

- receiving from the wireless device (e.g. device 10 or 20) user identification (Figs. 9 and 10, pages 4, lines 12-page 5, lines 8);

- sending an address list identified through use of the user identification from the web site to the wireless device (Figs. 9 and 10, pages 4, lines 12-page 5, lines 8);

- sending a plurality of preconfigured messages identified through use of the user identification from the web site to the wireless device, each of the plurality of messages being predefined ("preconfigured") to be sent to a recipient (Fig. 5, pages 4, lines 12-page 5, lines 8);

- receiving a message and the recipient from the wireless device, wherein the message is selected from the preconfigured messages by a user through the wireless device, and wherein the recipient is selected from the address list by the user through the wireless device (Figs 9 and 10, pages 4, lines 12-page 5, lines 8); and

sending the message to the recipient through the global computer network (page 29, lines 20-23)

With regard to claim 14:

Puskala further discloses storing the preconfigured messages on the storage device (page 28, lines 4-page 29, lines 5).

With regard to claim 15:

Puskala further discloses sending user interface data (Fig. 5) to a client computer to present an edit user interface on the client computer; and receiving a change from the client computer to change one of the preconfigured messages (page 15, lines 5-24).

With regard to claim 18:

Puskala further discloses that the web server serves the web data to a plurality of mobile telephones (Fig. 1, 10 and 20).

With regard to claim 19:

Puskala further discloses that the web server serves the web data to a plurality of personal digital assistants (page 9, lines 8-13).

With regard to claim 23:

Puskala further discloses that the message is an e-mail message and wherein the method further comprises e-mailing the e-mail message to the recipient through the global computer network (page 1, lines 10-13).

With regard to claim 24:

Puskala further discloses that the web data comprises WML (page 13, lines 15-17).

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With regard to claim 29:

Puskala discloses a method for providing predefined ("preconfigured") messages (e.g., see screen 74 , Fig. 5) to a hand-held wireless telecommunications device (10) to be sent to a recipient (20) through use of a global computer network (30, 43), the method comprising:

- establishing electronic communication between the wireless device (10) and the global computer network (30) (Fig. 1, page 9, lines 8-16);

- establishing electronic communication between the wireless device (10) and a web site storing preconfigured messages (at message database 31), each of the messages being preconfigured to be sent to a recipient (20) (page 14, lines 1-14);

- retrieving destination address (address list) from the web site based on user identification (page 14, lines 1-14, page 19, lines 1-12);

- sending the address list to the wireless device (page 19, lines 1-12);

- providing to a user (10) a recipient user interface to select the recipient from the address list (page 23, lines 1-10);

- retrieving the preconfigured messages from the web site based on user identification (page 25, lines 17-24);

- sending the preconfigured messages to the wireless device (page 29, lines 6-page 30, lines 11);

- providing to the user a message user interface to select a message from the preconfigured messages (page 26, lines 1-24); and



sending the message to the recipient through the global computer network (30, 43) page 26, lines 1-24);

With regard to claim 30:

Puskala further discloses providing a client user interface to a client computer via the global computer network (30, 43) to enable the creation of the preconfigured messages that are stored (31) on the web site (page 14, lines 1-14).

With regard to claim 33:

Puskala further discloses that the wireless device is a mobile telephone (Fig. 2, #10).

With regard to claim 34:

Puskala further discloses that the wireless device is a personal digital assistant (page 9, lines 8-13).

With regard to claim 35:

Puskala further discloses that the message is a text message (page 16, lines 7-11, Fig. 5).

With regard to claim 37:

Puskala further discloses that the recipient user interface and the message user interface comprise WML instructions (page 13, lines 15-17).

With regard to claims 16, 17, 31, and 32:

Puskala discloses personal information data, such as destination database 32 at the game platform 40 and another destination database 65 at the wireless device. The destination databases 65 and 32, for example stores the predefined destination

address of each player (page 13, lines 1-14). The wireless device user (e.g., device 10 or 20 ) is allowed to edit or modify the destination address 65. The wireless device user (e.g., PDA or device 10) also receives the pre-selected or predefined destination addresses from the host (game platform (40)) via the Internet and mobile network 30 (page 23, lines 23-pages 24, lines 21).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 6, 21, 22, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puskala (WO 02/070088 A1) in view of Martin (US Pub No. 2002/0174106 A1).

With regard to claims 5, 6, 21, 22, and 36

While Puskala discloses a hand-held wireless telecommunications device (10) displaying a text message as defined in claim 1 (see Fig. 5), but Puskala does not describe that the message is a text message that includes a token. Puskala further fails to describe that the messaging module allows the user to enter token text to replace the token in the message. Martin, however, discloses placeholder tokens, for data to be added by the user (paragraphs 65, 66, 70, 77 and 78).

Puskala and Martin are analogous art because they are from the same field of endeavor, text information processing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the placeholder tokens with text message data of Puskala will enhance the editing and sending of the text messages, because as suggested by Martin, one only has to replace the placeholder token, instead of rewritten the whole text messages (paragraphs 65, 66, 70, 77 and 78).

Therefore, it would have been obvious to combine Puskala with Martin to obtain the invention as specified in claims 5, 6, 21, 22, and 36.

5. Claims 9-12, 25-28 and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puskala (WO 02/070088 A1) in view of Graham (US Pub No. 2002/0178353 A1)

With regard to claims 9-12, 25-28 and 38-40:

Puskala describes customized application-specific software, which may be written in a language such as wireless markup language (WML) or Java, and alternatively, Puskala describes the messaging application 62 may comprise web access software (page 13, lines 11-23). But Puskala does not describe all HTML-compliant description languages, such as HTML, XHTML, HDML, and XML. However, Graham describes HTML, XHTML, HDML, and XML (see paragraph 32) as recited in the above claims.

Puskala and Graham are analogous art because they are from the same field of endeavor, electronic messaging.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the HTML-compliant description languages with Puskala's WAP browser software.

The suggestion/motivation for doing so would have been to provide a WAP users to browse HTML-complaint content using the mobile phone effectively (Puskala, page 11, lines 21-page 12, lines 7).

Therefore, it would have been obvious to combine Puskala with Graham to obtain the invention as specified in claims 9-12, 25-28 and 38-40:

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. 1.111(c) to consider this reference fully when responding to this action. The documents cited, **Ballard (US Pat No. 6,727,916)**, therein teach a typical wireless device comprising a messaging module as recited in claims 1, 13, and 29. Ballard further describes providing a user a message user interface (Quick Text Choice, e.g., FIG. 6b) to select a message from a plurality of predefined messages, each of the plurality of messages being predefined to be sent to a recipient (see Fig. 6b, wherein device 100 is sending predefined text message to device 102).

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8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 272-4051. The Examiner can normally be reached on M-F from 10:00 - 630 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 272-4048 Art Unit 2173.

9. An inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Examiner Tadesse Hailu  
Art Unit 2173  
4/11/05

